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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,570	12/20/2001	Kwok-Wai Lem	4820-5	9555

7590

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EXAMINER

KOSLOW, CAROL M

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 04/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,570

Applicant(s)

LEM ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g. 6) ☐ Other:

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Applicant's election with traverse of Group III, claims 19-21 in Paper No. 9, dated 24 February 2003, is acknowledged. The traversal is on the grounds that the claims are not independent and distinct because the claimed coating is applied by the claimed method using the claimed apparatus and thus are all linked. This is not found persuasive because the coating composition in claims 1-15, the apparatus claims is different from the coating composition of claims 19-21 in that the particles in claims 1-15 are not particle scattering colorants. Thus the claimed apparatus and claimed coating compositions are not linked and therefore are independent and distinct. The restriction between Groups I and II and Groups I and III was that the groups are related, but distinct; not that these groups were independent. Thus the argument with respect to the independence of these groupings, while considered, is given no weight. Applicants are reminded that under the statute an application may properly be required to be restricted to one of two or more claimed inventions if they are either independent or distinct. With respect to the arguments to the distinctiveness of Groups I and II, this argument is not persuasive since applicants have not shown that there is no material difference between the process and the apparatus. With respect to the arguments to the distinctiveness of Groups II and III, this argument is not persuasive since applicants have not shown coating composition can only be used in the claimed process or vice versa. The requirement is still deemed proper and is therefore made FINAL.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless

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the references have been cited by the examiner on form PTO-892 or by applicants on form PTO-1449 or a similar form, they have not been considered.

The articles indicated as not available in the information disclosure statement filed 27 January 2003 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The information referred to therein has not been considered.

Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite since the term "coating", claimed as such, is indefinite since it unclear if applicants are claiming the composition or a coating on a substrate. *Ex parte Scott* 66 USPQ 371 (PO BdPatApp 1945). If applicants are claiming a coating, and not the composition, then the substrate should be included in the claims.

The Examiner is interpreting the claims as being drawn to a coating composition.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. patent 6,086,780 and U.S. patent 5,948,321.

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Both of these references teach a coating composition comprising a matrix and nanosized magnetic iron oxide or manganese ferrite particles, which when exposed to a magnetic field, will agglomerate and exhibit a color. The color can be varied, and thus changed, by varying the magnetic field strength, which changes the agglomeration pattern of the particles. The taught particles have a particle size in the range of 5-10 nm, which means they are particle scattering colorants. The references teach the claimed coating compositions.

Claims 19 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Smith et al.

This reference teaches coating compositions comprising a matrix and particle scattering colorants. Column 27, lines 10-41 teaches a coating composition where the particle scattering colorants are photoferroelectric and it exhibits reversible photochromism, or color change, when exposed to photogenerated electric field. The color change is caused by the agglomeration of the particles, which results from the photogenerated electric field. The reference teaches the claimed coating compositions.

Claim 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

There is no teaching or suggestion in the cited art of record of a coating composition comprising a matrix and fine particles which comprise onion-skin method particles where at least one layer comprises a particle scattering colorant and at least one layer comprises at least one material having electric, magnetic and/or photo properties, where upon exposure to an electric, magnetic and/or photo field, the particles agglomerate and cause at least one color loss, color shift, color reduction, pattern scrambling or pattern loss.

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Jacobson is cited as of interest since it teaches a coating composition that comprising a matrix and colored particles that have an electric property, where upon exposure to an electric field, the particles agglomerate and cause a color shift. There is no suggestion in the art that the colorant can be a particle scattering colorant.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for Amendments filed under 37 CFR 1.116 or After Final communications is (703) 872-9311. The fax number for all other official communications is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk
April 2, 2003


C. Melissa Koslow
Primary Examiner
Tech. Center 1700